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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,148	07/31/2003	Elisabeth Borredon	454.002	1867

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EXAMINER

TUCKER, ZACHARY C

ART UNIT PAPER NUMBER

1624

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/632,148

Applicant(s)

BORREDON ET AL.

Examiner

Zachary C. Tucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7 and 9 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

As requested in the correspondence from applicants filed 14 July 2005 (hereinafter "present amendment"), which is in reply to the Office action mailed 8 February 2005 (hereinafter "previous Office action"), claims 3, 6, 7 and 8 have been amended.

***Status of Claim Rejections - 35 USC § 112***

In the previous Office action, claims 3, 6 and 7 were rejected under 35 U.S.C. 112, second paragraph, for indefiniteness of "benzene derivatives," "gradually," and "flow rate" (in the absence of a time dimension), respectively.

The present overcomes all of these rejections; they are hereby withdrawn.

***Status of Claim Rejections - 35 USC § 103***

In the previous Office action, claims 1, 2, 4-7 and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,453,516 (Fisher et al) in view of Smith and Linnhoff, *Chemical Engineering, Research and Design*, vol. 66, pages 195-228 (May 1988).

The rejection is maintained; applicants argument is not persuasive.

Claims 1, 2, 4-7 and 9 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al in view of Smith and Linnhoff for reasons of record. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the feature upon which applicant relies (i.e., N-methylation as opposed to C-methylation) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification

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are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Fisher et al patent teaches methylation of pyrrolidone, a nitrogenous heterocycle with a hydrogen atom bonded to nitrogen.

Applicants' argument makes reference to selectivity also. Neither is selectivity of the methylation reaction a claim limitation.

The argument in traversal furthermore states that making a batch process continuous, as is the rationale for the obviousness rejection at hand, is not obvious. Making a process continuous is well-established as being obvious – *In re Dilnot*, 319 F.2d 188, 138 USPQ 248 (CCPA 1963).

One of ordinary skill would certainly have a reasonable expectation of success in adapting Fisher et al's process for a continuous embodiment (especially in light of the fact that a continuous embodiment is expressly suggested in the reference).

Continuous removal of the by-product methanol would be necessary in the continuous practice of Fisher et al's methylation process.

### ***Allowable Subject Matter***

Claim 8 is allowed in view of the present amendment converting it into an independent claim. Reasons for allowability of claim 8 were given in the previous Office action, pages 6 and 7.

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base

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claim and any intervening claims. The substrates specified in instant claim 3 are not taught in the closest prior art, Fisher et al.

Claim 1 would be allowable if amended to specify N-methylation of nitrogenous heterocycles. Fisher et al teaches methylation of the alpha carbon of pyrrolidones and butyrolactones.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

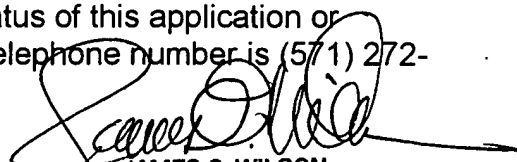
### **Conclusion**

Any inquiry concerning this communication should be directed to Zachary Tucker whose telephone number is (571) 272-0677. The examiner can normally be reached Tuesday-Thursday from 8:00am to 4:30pm or Monday from 6:00am to 1:30pm. If Attempts to reach the examiner are unsuccessful, contact the examiner's supervisor, James O. Wilson, at (571) 272-0661.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

zt



**JAMES O. WILSON**  
**SUPERVISORY PATENT EXAMINER**  
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